

**REMARKS**

**I. Status of the Claims**

Claims 27-73 are pending. Claim 31 has been cancelled without prejudice or disclaimer. Claims 32, 36, 39, 41 and 42 have been amended to overcome 35 U.S.C. § 112, second paragraph rejections, as will be further discussed below. The amendments are not intended to narrow the scope of the claims, nor does Applicant believe that they do.

Support for the amendments may be found throughout the specification and the claims. For example, support for the amendments to claims 32, 36, 39, 41 and 42 is found in original claims 4, 8, 9, 11, and 12, respectively. No new matter has been added.

**II. Election/Restriction**

Applicant notes that the Office has withdrawn from consideration several claims which read on Applicant's elected species. Specifically, claims 32-35, 46-48, and 70-71, were among the claims which Applicant indicated read on the elected species in the Response to Election of Species Requirement filed October 24, 2001, and yet these claims have been withdrawn from consideration by the Office. Applicant respectfully submits that these claims read on the elected species and must, therefore, be considered. If for any reason the Office does not agree that these claims should be considered, Applicant requests that the Office contact their undersigned representative at 202-408-4290, in order that this issue may be quickly resolved and all elected claims receive proper examination on the merits.

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**III. Provisional Obviousness - Type Double Patenting**

Claims 27-71 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-29 of copending Application No. 09/385,412 and over claims 1-33 of copending Application No. 09/385,015. Solely in an effort to expedite prosecution, and in no way acquiescing in the rejection, Applicants executed the attached Terminal Disclaimer.

**IV. Rejection Under 35 U.S.C. § 112**

The Office has rejected claims 31, 32, 36, 39, 41, 42, 46, 48, 51, 52, 54-57 and 59 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention.

(i) Regarding the rejection of claim 31, Applicant has by this Amendment canceled claim 31, thereby rendering this reason for rejection moot.

(ii) Regarding claim 32, the Office has alleged that it is vague and indefinite because it is not clear how the blocks are obtained from (1) and/or (2) and/or (3). However, as the Office is well aware, reading claim language in isolation is not appropriate for determining definiteness. Rather, "[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." M.P.E.P. § 2173.02. In the present case, Applicant submits that the language of claim 32 is described throughout the specification and examples are provided. See, e.g., page 4, line 23 to page 8, line 7 and composition I at page 37. Furthermore, as the Office is well aware, block polymers and methods for obtaining

them are well known in the art. Applicant respectfully submits that in light of teachings of the specification and the knowledge available in the art, that one of ordinary skill would be sufficiently apprised of how the arrangement of blocks forming polycondensate (A) may be obtained. For at least these reasons, this reason for rejection should be withdrawn.

(iii) Still regarding claim 32, the Office has alleged that the term "active" is a relative term which renders the claim indefinite. Applicant respectfully disagrees. In the present case, the specification contains a myriad of examples of compounds which may be used as the "at least one compound which contains at least two active hydrogen atoms per molecule." See *e.g.*, p. 5, line 5 to p. 7, line 8. Furthermore, the term "active" as used in the claims is a well known term of art as evidenced by the art of record. See *e.g.*, the Abstract of U.S. Patent No. 6,277,386, which was cited by the Office on the PTO 892 accompanying the Office Action. Applicant respectfully submits that in light of teachings of the specification and the knowledge available in the art, that one of ordinary skill would be sufficiently apprised of the term "active" in the context of the claimed invention. For at least these reasons, this reason for rejection should be withdrawn.

(iv) Regarding claim 36, the Office has alleged that it is not clear how the polycondensate can be formed from silicones when it comprises polyurethanes and polyurea blocks. Applicant asserts that the language of claim 36 is clear when read in light of the context of claim 29, from which it indirectly depends. The at least one polycondensate (A) comprising at least one block chosen from polyurethane and polyurea blocks, as recited in claim 29, is formed from at least one additional compound

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having a silicone skeleton, formed from polysiloxanes, polyalkylsiloxanes and polyarylsiloxanes, as recited in claim 36. Accordingly, Applicant requests that this reason for rejection be withdrawn.

(v) Regarding claims 32 and 39, the Office has alleged that the phrase "carbon-based" is vague and indefinite. However, claims 32 and 39 do not contain the phrase "carbon-based". Accordingly, Applicant requests that this reason for rejection be withdrawn.

(vi, ix, x, and xi) The Office has alleged that in claim 41, the phrase "divalent radical derived from isophorone" is vague and indefinite because it is not clear what compounds are encompassed by this phrase. Similarly, regarding claim 46, the Office has alleged that the phrase "units derived from sulphonic acid" is indefinite. Regarding claims 48, 52, and 54-57 the Office has alleged that the phrase "derived from" is vague and indefinite. Additionally, regarding claim 51, the Office has alleged that the term "phenylvinyl derivatives" is vague and indefinite.

However, in light of the specification and the knowledge available in the art, these phrases reasonably define the scope of the claimed subject matter. Both "derive" and "derivative" are clearly defined in terms of chemistry in The American Heritage College Dictionary (Third Edition). For example, the verb "derive" is defined as "4. *Chem.* To produce or obtain (a compound) from another substance by chemical reaction." Further, "derivative" is defined as "4. *Chem.* A compound derived or obtained from another and containing essential elements of the parent substance."

Thus, for example, the phrase "units derived from sulphonic acid" clearly defines that the metes and bounds of this phrase include that suitable units according to

this claim are those units produced or obtained from sulphonic acid by chemical reaction and which contain essential elements of the parent acid. Examples of such units derived from sulphonic acid are provided at page 18, line 28 to page 19, line 2 of the specification.

For similar reasons, the metes and bounds of the phrase "divalent radical derived from isophorone" in claim 41; the term "derived from" in claims 48 and 52; as well as the term "phenylvinyl derivatives" in claim 51, are also definite. Thus, Applicant asserts that the rejected language, when properly analyzed, is definite and reasonably conveys the metes and bounds of the invention. For at least these reasons, the reasons for rejection of claims 41, 46, 48, 51, 52 and 54-57 should be withdrawn.

(vii) The Office has alleged that the phrase "aromatic type" in claims 39 and 42 is vague and indefinite. Claims 39 and 42 have been amended to overcome this rejection. Therefore, Applicant requests that this reason for rejection be withdrawn.

(viii) Regarding claim 46, the Office has alleged that the term "lower" is a relative term which renders the claim indefinite. However, "lower alkyl" is a well known term of art. Further, examples of lower alkyls are given in the specification at page 16, lines 12-14. Therefore, the skilled artisan would be sufficiently apprised of the meaning of the term "lower alkyl," and this reasons for rejection should be withdrawn.

(xii) The Office has alleged that the phrase "functionalized and non-functionalized" in claim 59 is vague and indefinite because it is not clear what limitations this phrase places on polyurethanes. However, the phrase is very well known in the art and simply means that the silicone and non-silicone polyurethanes of claim 59 may be substituted or unsubstituted with functional groups. Therefore, the skilled artisan would

be sufficiently apprised of the meaning of the phrase "functionalized and non-functionalized." Accordingly, Applicant requests that this reasons for rejection be withdrawn.

**V. Rejections Under 35 U.S.C. § 103(a)**

The Office has rejected claims 27-31, 39-41, 43-45, 58 and 60-69 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,166,093 (Mougin '093), U.S. Patent No. 5,643,581 (Mougin '581) or EP 0 751 162 (Mondet) in view of U.S. Patent No. 5,653,963 (Beitone) for the reasons given a pages 5-6 of the Office Action. Applicant respectfully disagrees with the rejection for the reasons which follow.

As an initial matter, the Mougin '093 reference appears to be an English language equivalent of Mondet, as indicated by the attached patent family search results. Therefore, in the following remarks, Applicants' citations to Mougin '093 also apply to Mondet.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references must teach or suggest all the claimed limitations. See M.P.E.P. § 2143. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Applicant's claims recite, *inter alia*, "in a cosmetically acceptable medium, at least one polycondensate (A) comprising at least one block chosen from polyurethane and polyurea blocks and at least one film-forming polymer (B)". See e.g., claim 27.

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The Office has alleged that Mougin '093, Mougin '581, and Mondet teach compositions of "polyurethane and/or polyurea block polycondensation products containing silicone grafts, wherein formula I' (as recited in claim 39) of the instant invention is disclosed." See Office Action, p. 5. According to the Office, "the silicon grafts are disclosed as comprising a polysiloxane portion and a non-silicone organic chain portion." See Office Action, p. 5-6. The Office Admits that Mougin '093, Mougin '581, and Mondet "fail to teach a device." Office Action, p. 6, [*Emphasis added*].

In order to cure the deficiencies of Mougin'093, Mougin '581, and Mondet, the Office relies upon Beitone. Beitone allegedly teaches "aerosol systems for hair lacquer equipped with a dispensing valve and comprising a composition of water, organic solvent and film forming resin." See Office Action, p. 6. According to the Office, "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the compositions of Mougin'093, Mougin'581, and Mondet in the aerosol system of Beitone." Office Action, p. 6.

Contrary to the Offices remarks, Mougin'093, Mougin'581, and Mondet fail to teach more than just a device. Mougin'093, Mougin '581, and Mondet also fail to teach or suggest the composition recited in the claims comprising both the at least one polycondensate (A) comprising at least one block chosen from polyurethane and polyurea blocks, and the at least one film-forming polymer (B). Instead, as pointed out by the Office, Mougin'093, Mougin '581, and Mondet merely teach compositions of polyurethane and or polyurea block polycondensation products containing silicone grafts. See e.g., Mougin'093, column 2, lines 13-17 and Mougin'581, column 2, lines 30-34. None of the Mougin'093, Mougin'581 and Mondet references teaches or

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suggests a composition comprising at least one polycondensate and at least one film forming polymer, as is claimed.

Furthermore, Beitone does not cure the deficiencies of Mougin'093, Mougin'581 and Mondet because the requirements for establishing a *prima facie* case of obviousness, as outlined above, have not been met. Beitone is relied upon for disclosing an aerosol system, however, the composition in this system is different from the composition in Mougin '093, Mougin '581, and Mondet. The Examiner has not set forth where any of the cited references teaches or suggests the requisite motivation to make the modification needed to arrive at the claimed invention, nor do the references themselves provide the requisite suggestion. The Office's alleged motivation that an aerosol composition inherently implies a composition within a dispenser does not address the failure of Mougin'093, Mougin '581, and Mondet to teach or suggest Applicant's claimed composition.

Similarly the Offices' argument that Mougin'093, Mougin '581, Mondet and Beitone all teach hair care compositions in the form of compositions comprising water, organic solvents and film forming agents also does not address the failure of Mougin'093, Mougin '581, and Mondet to teach Applicant's claimed composition, comprising at least one polycondensate (A) comprising at least one block chosen from polyurethane and polyurea blocks and at least one film-forming polymer (B). Notably, no such hair care compositions are taught by Mougin'093, Mougin '581 or Mondet. Rather, the hair care compositions taught by Mougin'093, Mougin '581 and Mondet comprise psuedo-latex, fragrances, dyes, preservative and demineralized water. See,



for example, Mougin '093, column 23, lines 1-7 and 19-24 and Mougin '581, column 18, lines 57-64.

Thus, the similarities alluded to by the Office between the compositions of Beitone and those of Mougin'093, Mougin '581 and Mondet, do not exist. For all of the above reasons, Applicant asserts that the requisite motivation would not have existed to make the modifications needed to arrive at the claimed invention. Therefore, the rejections should be withdrawn.

Additionally, the Office has failed to set forth where, if at all, the cited prior art provides a reasonable expectation that the necessary modifications to the art would have succeeded. Indeed, Applicant asserts that the fact that Mougin'093, Mougin '581, and Mondet teach very different compositions from those of Beitone would suggest that there would have been no reasonable expectation for success. Without a showing of at least some reasonable expectation of success, no *prima facie* case of obviousness has been established. For this additional reason, Applicant respectfully requests that the Examiner withdraw the rejections and allow the pending claims.

For at least these reasons, none of the references, either alone or in combination, renders obvious the claimed invention. The Examiner has failed to establish a *prima facie* case of obviousness; thus reconsideration and withdrawal of this rejection are respectfully requested.

## **VI. Conclusion**

Applicant respectfully requests reconsideration of this application, and timely allowance of the pending claims.

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If for any reason the Examiner believes that prosecution of this application may be expedited by a conversation with Applicant's undersigned representative, a telephone call would be greatly appreciated. Applicant's undersigned representative may be reached by telephone at (202) 408-4290.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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## APPENDIX

Version of amended claims with markings to show changes made, pursuant to 37 C.F.R. 1.121(c)(1)(ii).

Claims 32, 36, 39, 41 and 42 were amended, as follows:

32. (Amended) The device according to claim [31] 29, wherein the at least one polycondensate (A) is formed by an arrangement of blocks, said arrangement of blocks [is] being obtained from:

- (1) at least one compound which contains at least two active hydrogen atoms per molecule;
- (2) at least one substance chosen from at least one diol containing at least one acid radical and the salts of said at least one diol; and
- (3) at least one isocyanate chosen from di- and polyisocyanates.

36. (Amended) The device according to claim [31] 29, wherein the at least one polycondensate (A) is formed from at least one additional compound having a silicone skeleton[,] chosen from polysiloxanes, polyalkylsiloxanes and polyarylsiloxanes.

39. (Amended) The device according to claim 29, wherein the at least one polycondensate (A) has a repeating base unit corresponding to the formula I' below:



in which:

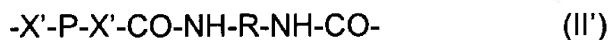
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- X' is chosen from O and NH,
- B is a hydrocarbon-based radical, this radical being substituted or unsubstituted, and
- R is a divalent radical chosen from aromatic alkylene radicals [of aromatic type], C<sub>1</sub> to C<sub>20</sub> aliphatic radicals and C<sub>1</sub> to C<sub>20</sub> cycloaliphatic radicals, these radicals being substituted or unsubstituted.

41. (Amended) The device according to claim 39, wherein the radical R is chosen from hexamethylene, 4,4'-biphenylenemethane, 2,4- and 2,6-tolylene, 1,5-naphthylene, p-phenylene, methylene-4,4-bis-cyclohexyl radicals and [the] divalent radicals derived from isophorone.

42. (Amended) The device according to claim 29, wherein the at least one polycondensate (A) has a repeating base unit corresponding to formula (II'):



in which:

- P is a polysiloxane segment,
- X' is chosen from O and NH, and
- R is a divalent radical chosen from aromatic alkylene radicals [of aromatic type], C<sub>1</sub> to C<sub>20</sub> aliphatic radicals and C<sub>1</sub> to C<sub>20</sub> cycloaliphatic radicals, these radicals being substituted or unsubstituted.

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